



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/730,299	12/05/2000	Kenneth H. Falchuk	healre01.012	7848
25247 7590 07/21/2009 GORDON E NELSON PATENT ATTORNEY, PC 57 CENTRAL ST PO BOX 782 ROWLEY, MA 01969				
EXAMINER				
PASS, NATALIE				
ART UNIT		PAPER NUMBER		
3686				
NOTIFICATION DATE		DELIVERY MODE		
07/21/2009		ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

genelson@comcast.net

Office Action Summary

Application No.

09/730,299

Applicant(s)

FALCHUK ET AL.

Examiner

Natalie A. Pass

Art Unit

3686

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 April 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No. (s) / Mail Date: _____
- 4) ☐ Interview Summary (PTO-413)
Paper No. (s) / Mail Date: _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Notice to Applicant

1. This communication is in response to the amendment filed 22 April 2009. Claims 1-4 have been amended and remain pending.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. § 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 1-4 are rejected under 35 U.S.C. § 101 for substantially the same reasons given in the previous Office Action (paper number 20081224), because the claimed invention is still directed to non-statutory subject matter.

A) Method claims 1-4 have been amended to include the recitation of “via a telecommunications system” and “storing the request in the storage device” and “processor” throughout the body of the claims. As per claims 1-4, these appear to be directed toward a method or process for providing a continuing medical education credit. Claims 1-4 still fail to satisfy the requirements for statutory subject matter eligibility because they are considered to be drawn merely to the production and/or manipulation of non-functional descriptive material, effecting no practical application. It has been held that such claims, even if the non-functional descriptive material is claimed in combination with a computer-readable medium, are considered

to comprise non-statutory subject matter, for merely manipulating an abstract idea. *In re Lowry*, 32 USPQ2d 1031 (Fed. Cir. 1994). See MPEP § 2106.01.

When nonfunctional descriptive material is recorded on some computer-readable medium, in a computer or on an electromagnetic carrier signal, it is not statutory since no requisite functionality is present to satisfy the practical application requirement. Merely claiming nonfunctional descriptive material, i.e., abstract ideas, stored on a computer-readable medium, in a computer, or on an electromagnetic carrier signal, does not make it statutory.

In the instant case, the request for a consultation and the comment from the second physician are merely stored to be read or outputted by a computer without any functional interrelationship with the computer, and thus do not impart any functionality to the computer.

Moreover, in claims 1-4, the computer and the telecommunications system are only nominally recited as a venue on which the method steps are performed, and nominal recitations of structure in an otherwise ineligible method fail to make the method a statutory process (See *Benson*, 409 U.S. at 71-72).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fontelo, P.A. Continuing medical education on the World Wide Web. Military Telemedicine On-Line Today, 1995. 'Research, Practice, and Opportunities', Proceedings of the National Forum 27-29 March 1995. URL:

<<http://ieeexplore.ieee.org/iel3/3745/10944/00504546.pdf?tp=&number=504546&isnumber=10944>>, hereinafter known as Fontelo, and further in view of Bringing Health Care Online: The Role of Information Technologies, Chapter 5: Telemedicine: Remote Access to Health Services and Information article, September 1995, URLs:

<<http://www.wws.princeton.edu/ota/disk1/1995/9507/950707.PDF>> and

<<http://www.wws.princeton.edu/ota/disk1/1995/9507/950701.PDF>>, hereinafter known as Remote, for substantially the same reasons given in the previous Office Action (paper number 20081224). Further reasons appear hereinbelow.

(A) Claims 1-2 have been amended to include the recitations of

- “via a telecommunications system” and “an intermediary having a processor and a storage device to which the processor has access” and “performed in the intermediary using the processor” in the preamble, and
- “storing the request in the storage device” and “storing the comment” and “accessible to the processor” throughout the body of the claims.

As per newly amended claim 1, Fontelo and Remote teach a method as analyzed and discussed in the previous Office Action (paper number 20081224) further comprising

the first and second physicians being coupled “via a telecommunications system” to “an intermediary having a processor and a storage device to which the processor has access” and “performed in the intermediary using the processor” (Fontelo; paragraph bridging pages 141-142); Examiner interprets Fontelo’s teachings of “[p]hysicians can transmit digitized images through the Internet [a telecommunications system], which can then be archived on the WWW server [stored in the intermediary] and be accessible to pathologists worldwide” to teach a form of “the first and second physicians being coupled via a telecommunications system to an intermediary having a processor and a storage device to which the processor has access;” and “storing the request in the storage device” and “storing the comment” and the recorded information regarding the consultation “accessible to the processor” (Fontelo; page 142, paragraph bridging columns 1-2); Examiner interprets Fontello’s teachings of a “hypermedia module containing patient radiographs, imaging studies, gross and microscopic specimen photographs, presented with patient case histories in a case study page. The thumbnail images initially shown are linked to larger 24-bit images. Links to a question page, an evaluation summary page and other relevant pages are provided” (emphasis added) and “a convenient response page linked to every case is easily accomplished” to teach a form of storing the request and comment in the storage device and the recorded “information concerning the consultation” being accessible to the processor.

As per the remaining amendments to claims 1-2, these appear to have been made merely to correct errors in the claim language and to correct claim rejections in the prior Office Action under 35 U.S.C. § 101. While these changes render the language of the claims smoother and

more consistent, they otherwise affects neither the scope and breadth of the claims as originally presented nor the manner in which the claims were interpreted by the Examiner when applying prior art within the previous Office Action.

As such, the recited claimed features are rejected for the same reasons given in the prior Office Action (paper number 20081224, section 7, pages 4-7), incorporated herein.

The motivations for combining the respective teachings of Fontelo and Remote are as given in the rejection of claim 1 in the previous Office Action (paper number 20081224), and incorporated herein.

6. Claims 3-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fontelo, P.A. Continuing Medical Education on the World Wide Web. Military Telemedicine On-Line Today, 1995. 'Research, Practice, and Opportunities.', Proceedings of the National Forum, 27-29 March 1995. URL:

<<http://ieeexplore.ieee.org/iel3/3745/10944/00504546.pdf?tp=&arnumber=504546&isnumber=10944>>, hereinafter known as Fontelo, and Bringing Health Care Online: The Role of Information Technologies, Chapter 5: Telemedicine: Remote Access to Health Services and Information article, September 1995, URLs:

<<http://www.wws.princeton.edu/ota/disk1/1995/9507/950707.PDF>> and

<<http://www.wws.princeton.edu/ota/disk1/1995/9507/950701.PDF>>, hereinafter known as Remote, as applied to claims 1 and 2 above, and further in view of Galewitz, P., Doctors Can Now Get Continuing Education On-Line. Palm Beach Post. Jul 8, 1996. URL:

<<http://proquest.umi.com/pqdweb?did=66323909&sid=4&Fmt=3&clientId=19649&RQT=309&>

VName=PQD>, hereinafter known as Galewitz for substantially the same reasons given in the previous Office Action (paper number 20081224). Further reasons appear hereinbelow.

(A) Claims 3-4 have been amended to include the recitations of

- “via the telecommunications system” throughout the body of the claims.

As per newly amended claims 3-4, Fontelo, Remote and Galewitz teach a method as analyzed and discussed in the previous Office Action (paper number 20081224) further comprising

providing an examination and receiving the answers via the telecommunications system (Galewitz, page 1, paragraph 5-6).

As per the remaining amendments to claims 3 and 4, these appear to have been made merely to correct errors in the claim language and to correct claim rejections in the prior Office Action under 35 U.S.C. § 101. While these changes render the language of the claims smoother and more consistent, they otherwise affect neither the scope and breadth of the claims as originally presented nor the manner in which the claims were interpreted by the Examiner when applying prior art within the previous Office Action.

As such, the recited claimed features are rejected for the same reasons given in the prior Office Action (paper number 20081224, section 8, pages 7-9), incorporated herein.

The motivations for combining the respective teachings of Fontelo, Remote and Galewitz are as given in the rejection of claims 1 and 3 in the previous Office Action (paper number 20081224), and incorporated herein.

Response to Arguments

7. Applicant's arguments on pages 4-7 of the response filed 22 April 2009 have been fully considered but they are not persuasive. Applicant's arguments will be addressed hereinbelow in the order in which they appear in the response filed 22 April 2009.

(A) At pages 4-5 of the 22 April 2009 response Applicant argues the rejections of method claims 1-4 under 35 U.S.C. §101 in light of amendments to the claims. Applicant's arguments have been fully considered but they are not persuasive, as detailed in Section 3 above. As noted above, Examiner submits that the newly amended recitations of "via a telecommunications system" and "storing the request in the storage device" and "processor" provides only a nominal recitation of a computer as a venue on which the method steps are performed, and Examiner submits that court decisions have determined that nominal recitations of structure in an otherwise ineligible method fail to make the method a statutory process (See *Benson*, 409 U.S. at 71-72). Moreover, as *Comiskey* recognized, "the mere use of the machine to collect data necessary for application of the mental process may not make the claim patentable subject matter." *Comiskey*, 499 F.3d at 1380 (citing *In re Grams*, 888 F.2d 835, 839-40 (Fed. Cir. 1989)). In other words, nominal or token recitations of structure in a method claim should not convert an otherwise ineligible claim into an eligible one, as this circumvents the principles underlying the Supreme Court's interpretation for "process." Accordingly, these rejections are maintained.

Furthermore, claims 1-4 fail to satisfy the requirements for statutory subject matter eligibility because they are considered to be drawn merely to the production and/or manipulation of non-functional descriptive material, effecting no practical application. It has been held that such claims, even if the non-functional descriptive material is claimed in combination with a computer-readable medium, are considered to comprise non-statutory subject matter, for merely manipulating an abstract idea. *In re Lowry*, 32 USPQ2d 1031 (Fed. Cir. 1994). See MPEP § 2106.01. When nonfunctional descriptive material is recorded on some computer-readable medium, in a computer or on an electromagnetic carrier signal, it is not statutory since no requisite functionality is present to satisfy the practical application requirement. Merely claiming nonfunctional descriptive material, i.e., abstract ideas, stored on a computer-readable medium, in a computer, or on an electromagnetic carrier signal, does not make it statutory. In the instant case, the request for a consultation and the comment from the second physician are merely stored to be read or outputted by a computer without any functional interrelationship with the computer, and thus do not impart any functionality to the computer.

(B) At pages 4-7 of the 22 April 2009 response Applicant argues that the features claimed in the Application are not taught or suggested by the applied references. In response, all of the limitations which Applicant disputes as missing in the applied references, including limitations recited in the preamble, and including the newly added limitations of the amendment filed 22 April 2009, have been fully addressed by the Examiner as either being fully disclosed or obvious in view of the combined teachings of Fontelo, Remote, and Galewitz, based on the logic and sound scientific reasoning of one ordinarily skilled in the art at the time of the invention, as

detailed in the remarks and explanations given in the preceding sections of the present Office Action and in the prior Office Action (paper number 20081224), and incorporated herein.

As per Applicant's arguments on pages 5-6 of the amendment filed 22 April 2009 that the applied references fail to teach the features of "receiving a request for a consultation from the first physician" as recited in claim 1, and arranging the consultation "and then making the arranged consultation between the doctors the basis for the granting of CME credit for the doctor who made the consultation request," Examiner respectfully disagrees, as discussed below.

Examiner notes that Applicant analyzes the applied references separately and argues each of the references individually. In response to Applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In addition, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

Accordingly, Examiner submits that Fontelo's teachings of "[t]he established method of earning CME credit has been through participation in conferences, seminars, meetings, and workshops sponsored by academic institutions [*'intermediaries'*]. CME credit can also be

obtained by correspondence courses [offered by '*intermediaries*'] and through audiovisual materials. Recently, a modification of the standards was made to encourage more independent learning" (Fontelo; page 141, column 1, paragraph 3) together with Fontelo's teachings of "[t]he Uniformed Services University of the Health Sciences (USUHS) Department of Pathology (<http://www.path.usu2.usuhs.mil>) [an '*intermediary*'] has undertaken a project to provide CME through the World Wide Web. ... [...] ... This CME activity is considered part of Category 1 Enduring Materials ... [...].... The primary goal of the project is to provide CME to uniformed services physicians [i.e. '*first physicians*'] especially those in remote sites in the continental United States and overseas. A secondary goal is to serve physicians and allied medical practitioners in the civilian sector ... [...]This site may also be used as a forum for exchanging diagnostic opinions [i.e., '*consultations*']" (emphasis added) (Fontelo; paragraph bridging pages 141-142) together with Fontelo's teachings of "[p]hysicians can transmit digitized images through the Internet, which can then be archived on the WWW server and be accessible to pathologists [i.e. a '*second physician with expertise*']" (emphasis added) (Fontelo; paragraph bridging pages 141-142) and "a physician can get to this hypermedia module containing patient radiographs, imaging studies, gross and microscopic specimen photographs, presented with patient case histories in a case study page. ... [...] Links to a question page, an evaluation summary page and other relevant pages are provided. Participants must return a question and evaluation form to USUHS to receive credit. A convenient response page linked to every case is easily accomplished" (emphasis added) (Fontelo; page 142; column 1, paragraph 1 to column 2, paragraph 1) to teach a form of "receiving a request for a consultation from the first

physician” as recited in claim 1, and arranging the consultation “and then making the arranged consultation between the doctors the basis for the granting of CME credit for the doctor who made the consultation request. Examiner submits that these teachings together with the Remote reference teachings which explicitly state “[t]he system is designed to provide real-time medical consultations involving a patient and practitioner ... [...] ... at the distant end and a specialist at the medical center” (emphasis added) (Remote; page 169, column 1, lines 3-7) and “[p]hysicians in remote areas who use the MCG [Medical College of Georgia] system [an ‘*intermediary*’] for consultations are given credit hours toward meeting their continuing medical education (CME) requirements, which are necessary for license renewals” (emphasis added) (Remote; page 168, column 1, paragraph 1) to teach the argued features.

With respect to Applicant’s argument on page 6 of the amendment filed 22 April 2009 that a *prima facie* case of obviousness has not been established the Examiner respectfully submits that obviousness is determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Hedges*, 783 F.2d 1038, 1039, 228 USPQ 685,686 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785,788 (Fed. Cir. 1984); and *In re Rinehart*, 531 F.2d 1048, 1052, 189 USPQ 143,147 (CCPA 1976). Using this standard, the Examiner respectfully submits that the burden of presenting a *prima facie* case of obviousness has at least been satisfied, since evidence has been presented of corresponding claim elements in the prior art and the combinations and the motivations for combinations that fairly suggest

Applicant's claimed invention (see paper number 20081224 and present Office Action) have been expressly articulated.

With regard to Applicant's arguments on page 6, last paragraph of the amendment filed 22 April 2009 that the applied references fail to teach retrieving instructional material relevant to the comment and the consultation, and providing the instructional material to the first physician via the telecommunications system as recited in claim 2, Examiner respectfully disagrees. Examiner interprets Fontelo's teachings of "[t]he WWW, with its hypermedia capability, has afforded a new medium for delivering text, images, and graphics. It becomes an ideal platform for disseminating [relevant] CME materials. One advantage of CME information on a WWW server is its potential for user access on their own time (asynchronous mode). The worldwide distribution of the Internet permits an efficient method of information dispersion, one "instructor" (server) for a multitude of potential students. The Uniformed Services University of the Health Sciences (USUHS) Department of Pathology [an 'intermediary'] (<http://www.path.usuf2.usuhs.mil>) has undertaken a project to provide CME through the World Wide Web" to teach a form of retrieving instructional material relevant to the comment and the consultation, and providing the instructional material to the first physician via the telecommunications system by the intermediary (i.e. The Uniformed Services University of the Health Sciences) (Fontelo; page 141, column 2, paragraph 2 to page 142, column 1, paragraph 2).

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited but not applied reference Siefert et al., U.S. Patent Number 5810605 teaches the environment of providing online education and accreditation.

9. **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

10. **Any response to this final action should be mailed to:**

Box AF
Commissioner of Patents and Trademarks
Washington D.C. 20231

or faxed to: (571) 273-8300.

For formal communications, please mark "EXPEDITED PROCEDURE".

For informal or draft communications, please label "PROPOSED" or "DRAFT" on the front page of the communication and do NOT sign the communication. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Natalie A. Pass whose telephone number is (571) 272-6774. The examiner can normally be reached on 9-6:30 Monday - Thursday and alternate Fridays.

11. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry O'Connor can be reached on (571) 272-6787. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

12. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or (571) 272-1000.

/N. A. P./
Examiner, Art Unit 3686
July 11, 2009

/Gerald J. O'Connor/
Supervisory Patent Examiner
Group Art Unit 3686